



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,860	11/28/2000	Andrew Welcher	99,372-A	9408

20306 7590 09/24/2003

MCDONNELL BOEHNEN HULBERT & BERGHOFF  
300 SOUTH WACKER DRIVE  
SUITE 3200  
CHICAGO, IL 60606

EXAMINER

ANDRES, JANET L

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 09/24/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/724,860

Applicant(s)

WELCHER ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8,10,11 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,11 and 43-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **RESPONSE TO AMENDMENT**

1. Applicant's amendment filed 3 July 2003 is acknowledged. Claims 1-8, 10, 11, and 43-45 are pending and under examination in this application. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

#### ***Claim Rejections Withdrawn***

2. The rejection of claims 1, 2, 4-8, 10, and 11 under 35 U.S.C. 112, first paragraph, as lacking written description of allelic variants is withdrawn in response to Applicant's amendment.

3. The rejection of claims 2-8, 10, 11, and 43-45 under 35 U.S.C. 112, first paragraph, as lacking enablement commensurate in scope with the claims and as lacking written description of variants is withdrawn in response to Applicant's amendment. However, this rejection may be reinstated in response to cancellation of the new matter: see below.

#### ***New Grounds of Objection/Rejection***

4. The rejection of claim 1 under 35 U.S.C. 112, first paragraph, as lacking enablement commensurate in scope with the claims and as lacking written description of variants is maintained for reasons of record in the office actions of paper no. 13. Applicant argues that one of skill in the art would recognize that the disclosed molecule was a novel interferon based on its intronless gene structure and conserved cysteine residues. Applicant further argues that signaling by interferons is well understood. Applicant's arguments with respect to antigenicity are noted but are not relevant to this claim.

Applicant's arguments have been fully considered but have not been found to be persuasive. Applicant has described one interferon-like molecule, but the claim encompasses

Art Unit: 1646

molecules of limited homology to this molecule. There is no requirement for any particular structure or function in the claim nor are any requirements that identify a genus set forth in the specification. One of skill in the art would not recognize that Applicant was in possession of the genus as claimed, nor would one of skill be able to make and use members of the genus commensurate in scope with the claims.

4. The amendment filed 3 July 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The claims now recite phosphorylation of Janus kinase. Phosphorylation of this enzyme is not supported by the specification, which does not mention Janus kinase.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. Claims 2-8, 10, 11, and 43-45 are newly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims now recite the limitation of phosphorylation of Janus kinase. However, this phosphorylation is not disclosed in the specification. While Applicant argues that it is a known feature of interferons, Applicant has not disclosed that this particular molecule has this function.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1646

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8, 10, 11, and 43-45 are newly rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,433,145 (LaFleur et al.; the filing date of the provisional application to which the patent claims priority is 21 July, 1998).

The '145 patent teaches a sequence, SEQ ID NO: 1, which encodes instant SEQ ID NO:

5. See figure 1 and attached sequence alignment.

NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly


Art Unit: 1646

signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.

September 23, 2003

  
JANET ANDRES  
PATENT EXAMINER